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REMARKS

Claims 1, 2, 4-6, 8-10, 12-14, and 16-34 are all of the claims presently pending in the application. Applicants have not amended the previously pending claims. Applicants have added claims 29-34 to claim additional features of the invention and to vary the protection for the claimed invention further.

Claim 22 stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to nonstatutory subject matter. Claims 23-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Munyan (U.S. Patent No. 5,761,485). Claims 1, 2, 4, 6-10, 12-14, 16-19, 22, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Munyan in view of Bogward (U.S. Publication No. 2004/0049743). Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Munyan in view of Bogward and Liao (U.S. Publication No. 2004/0021681). Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Munyan. Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Munyan in view of Bogward and Stanek (U.S. Patent No. 5,936,554).

Applicants respectfully traverse these rejections in the following discussion.

I. THE STATUTORY SUBJECT MATTER REJECTION

The Examiner has rejected claim 22 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Applicants point out that claim 22 recites: “A programmable storage medium tangibly embodying a program of machine-readable instructions executable by a digital processor for”

As such, because of the wording “tangibly embodying”, this description clearly

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addresses at least the signal-bearing media that are physically embodied, including at least memory embodiments on a computer, such as a hard drive or RAM, that are storing the program either for actually executing the method of the program or for storing the program for potentially execution at some future time. Likewise, this wording also covers the tangible embodiments of a standalone diskette, such as a floppy or CD, as based upon *In re Beauregard*, 53 F.3d 1583 (Fed Cir, 1995), and subsequently-issued US Patent No. 5,710,578 that issued on January 20, 1998, to Beauregard et al.

In the response to Applicants' previous arguments, the Examiner alleges, "the specification does not define what is meant by "tangibly embodied"; the broadest interpretation still includes transmission media, wire links, etc., which are non-statutory." (See Office Action dated November 13, 2008 at pages 12-13). The Examiner, however, is clearly incorrect.

That is, the term "tangibly" is a common term, which does not require Applicants' to define in the specification as the term is not being given special meaning. One of ordinary skill in the art would clearly understand what is meant by the term "tangibly."

The phrase "tangibly embodied" clearly addresses the signal-bearing media that are physically embodied, including at least memory embodiments on a computer, such as a hard drive or RAM, that are storing the program either for actually executing the method of the program or for storing the program for potentially execution at some future time or a standalone diskette, such as a floppy or CD, as illustrated in Figures 5 and 6 of the Application.

One of ordinary skill in the art would not consider transmission media or wire links to be tangible.

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Moreover, Applicants submit that the program of machine readable instructions, recited in claim 22, is clearly tied to an apparatus (a programmable storage medium).

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

II. THE PRIOR ART REFERENCES

A. Claims 23-27

The Examiner alleges that Munyan teaches the claimed invention of claims 23-27. Applicants submit, however, that Munyan does not teach or suggest each and every feature of the claimed invention.

That is, Munyan does not teach or suggest, “*wherein said touch-sensitive display displays a reconfigurable user-interface that overlays a portion of said single display output*”, as recited in exemplary claim 23 and similarly recited in exemplary claims 24 and 25.

Munyan merely teaches an electronic book system, which displays icons, each icon representing a product (see Munyan at column 7, lines 15-20). Once the user selects an icon, the two displays display printed material of the selected item (see Munyan column 8, lines 35-38). Accordingly, the user interface of Munyan maintains the same configuration. The user is provided a list of products, which the user may select. Once the user selects one of the products, the contents of the products are displayed.

Applicants note that the Examiner’s rejection of claims 23-27 fails to even address this feature of the claimed invention. Applicants submit that the Examiner must address each and every feature of the claimed invention.

Moreover, Applicants submit that the Examiner’s rejection of claim 26 is improper.

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That is, claim 26 currently stands rejected under 35 U.S.C. § 102(b) as being anticipated by Munyan (see Office Action dated November 13, 2008 at page 3). Claim 26, however, is a dependent claim, depending claim from claim 4, which depends from independent claim 1. Claims 1 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over an alleged combination of Munyan and Bogward (see Office Action dated November 13, 2008 at page 5).

Accordingly, since claims 1 and 4 are not anticipated by Munyan, the Examiner's rejection of claim 26, which depends therefrom, under 35 U.S.C. § 102(b) is clearly improper.

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggest by Munyan. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection.

B. Claims 1, 2, 4, 6-10, 12-14, 16-19, 22, and 28

The Examiner alleges that one of ordinary skill in the art would have combined Bogward with Munyan to teach the claimed invention of claims 1, 2, 4, 6-10, 12-14, 16-19, 22, and 28. Applicants submit, however, that one of ordinary skill in the art would have combined Bogward with Munyan as alleged by the Examiner.

The Examiner alleges, "Bogward disclosed an optional touch screen (Figure 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bogward into Munyan to allow the option of having both displays to be touch-sensitive or just one." (See Office Action dated November 13, 2008 at page 6).

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In general, Applicants respectfully submit that the rejection of record fails to satisfy *KSR's* requirement that “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

Applicants respectfully submit that the rejection of record provides no more than “mere conclusory statements.” Essentially, the method of evaluation in this rejection consists of nothing more than merely:

- Identifying a missing element;
- Describing a feature purportedly inherent in this missing element; and
- Summarily alleging that obviousness results because this inherent feature of this missing element would thereby be provided, in the abstract, by incorporating the missing element.

Applicants submit that this circular reasoning identified above is exactly the type of conclusory statements that the *KSR* holding expressly prohibits and constitutes an improper reasoning mechanism.

Applicants further submit that the underlying fundamental logical flaw in this evaluation approach is that the feature purported to be inherent in this missing element is not realistically related back to the primary reference and that the Examiner’s initial burden is not satisfied by simply pointing out features of the missing element, in the abstract, as done in the rejections of record.

Indeed, the rejections of record fail to follow any of the seven rationales now identified in the beginning of MPEP §2143 and previously published by the USPTO in its October 10, 2007, Federal Register Notices, in the aftermath of *KSR*.

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Indeed, the Examiner appears to be alleging that one of ordinary skill in the art would have included an optional touch screen in Munyan so that Munyan would have an optional touch screen. This circular reasoning is clearly insufficient to establish a prima facie case of obviousness.

The Examiner is essentially alleging that one of ordinary skill would have modified Munyan to include an optional touch screen simply because an optional touch screen is disclosed in an allegedly analogous reference.

Applicants submit, however, that is insufficient merely to establish that a feature is taught in a secondary reference. The Examiner must set forth why one ordinary skill in the art would have modified the primary reference to include the missing element. In doing so, the Examiner must consider the teachings of the primary reference.

The device in Munyan is an electronic system for reading books. Accordingly, the device displays the text of the book on the two display pages. The device allows the user to bookmark pages or select passages from the text using the touch screen capability.

The Examiner's alleged modification of Munyan suggests removing the touch screen capability (i.e., the book marking / pass selecting) from one of the touch screens or removing the text of the book from one of the display screens. One of ordinary skill in the art would have no reason to make such a modification.

Therefore, Applicants submit that one ordinary skill in the art would have combined the references as alleged by the Examiner. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

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C. Claim 20

The Examiner alleges that the claimed invention of claim 20 would have been obvious in view of Munyan.

Applicants point out, however, that the Examiner's rejection of claim 20 based solely upon Munyan is improper.

Indeed, claim 20 is a dependent claim depending from dependent claim 8. Claim 8 stands rejected over an alleged combination of Munyan and Bogward. Accordingly, a rejection of claim 20 must be based on at least a combination of Munyan and Bogward.

Moreover, Applicants submit that claim 20 is allowable at least based on similar reasons to those set forth above, in section B, with respect to claims 1, 2, 4, 6-10, 12-14, 16-19, 22, and 28.

Furthermore, the Examiner basically alleges that the feature of a drop-down menu on a touch screen display is well-known. The Examiner, however, has not provided any evidentiary support for this allegation. If the Examiner wishes to maintain this rejection, then Applicants respectfully request the Examiner provide a prior art reference, properly combinable with Munyan and Bogward, that illustrates the feature recited in dependent claim 20.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

D. Claim 5

The Examiner alleges that one of ordinary skill in the art would have combined Liao with Munyan and Bogward to teach the claimed invention of claim 5. Applicant submits,

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however, that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, claim 5 is allowable at least based on similar reasons to those set forth above, in section B, with respect to claims 1, 2, 4, 6-10, 12-14, 16-19, 22, and 28.

Therefore, Applicants submit that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

Therefore, Applicants respectfully request the Examiner to withdraw this rejection.

E. Claim 21

The Examiner alleges that one of ordinary skill in the art would have combined Stanek with Munyan and Bogward to teach the claimed invention of claim 21. Applicant submits, however, that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, claim 21 is allowable at least based on similar reasons to those set forth above, in section B, with respect to claims 1, 2, 4, 6-10, 12-14, 16-19, 22, and 28.

Therefore, Applicant submits that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

Therefore, Applicant respectfully requests the Examiner to withdraw this rejection.

III. NEW CLAIMS

Applicants have added new claims 29-34 to claim additional features of the invention and to vary the protection for the claimed invention further. These claims are independently patentable because of the novel and nonobvious features recited therein.

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Applicants submit that new claims 29-34 are patentable over the cited prior art references at least for analogous reasons to those set forth above with respect to claims 1, 2, 4-6, 8-10, 12-14, and 16-28.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submit that claims 1, 2, 4-6, 8-10, 12-14, and 16-34, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Applicant respectfully requests the Examiner to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, Applicant requests the Examiner to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The undersigned authorizes the Commissioner to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date: February 13, 2009

Respectfully Submitted,



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